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CASE PI/5-20691/A/PCT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

O'SULLIVAN ET AL.

APPLICATION NO: 09/091,333

FILED: OCTOBER 26, 1998

FOR: PROCESS FOR THE PREPARATION OF 2-CHLORO-5-CHLOROMETHYL-THIAZOLE

Art Unit: 1613

Examiner: R. Gerstl

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE UNDER RULE 111

Sir:

In response to the Office action of September 22, 2000, having a response period set to expire on December 22, 2000, here extended by request to expire on February 22, 2001, it is respectfully requested that the following remarks be entered and that the claims be reconsidered in light thereof.

Claims 1 – 68 were originally filed.

Claims 8, 11, 14, 17, 21, 25, 28, 32, 36, 39, 43, 47, 53, 57, 65 and 68 were canceled by amendment dated June 16, 1998.

Claims 15, 16, 18 – 20, 22 – 24, 26, 27, 29 – 31, 33 – 35, 37, 38, 40 – 42, 44 – 46, 48 – 52, 54 – 56, 58 – 64, 66 and 67 stand withdrawn pursuant to Rule 142(b).

Claim 10 was not rejected by the Examiner and presumably is allowed. **Th Examiner is respectfully requested to clarify the status of claim 10.**

Claims 1 – 7, 9, 12 and 13 are under consid ration herein.

Applicants respectfully traverse the § 112, second paragraph, rejection of claim 1. Applicants respectfully submit that one of ordinary skill in this art, having Applicants disclosure and claims before him, would be reasonably certain as to the exact subject matter encompassed by claim 1. Moreover, the Examiner's misjoinder argument does not obtain, as it clearly is appropriate to include interrelated process subject matter in a single claim. This interrelationship rather than the classification in separate classes should be the overriding factor in determining the propriety of the claim. Accordingly, Applicants submit that the § 112, second paragraph, rejection of claim 1 should be withdrawn. Reconsideration and withdrawal thereof are earnestly requested.

With regard to the Examiner's Rule 605(a) requirement, such a requirement is only applicable "If no claim in an application is drawn to the same patentable invention claimed in another application or patent,..." 37 CFR 605(a) (emphasis supplied). Applicants note that claim 2 of the present application that was presented on October 26, 1998 is drawn to the "same patentable invention" as the allowable claim suggested by the Examiner. See 37 CFR 601(n)[1]. Accordingly, no issue of disclaimer is applicable here.

Applicants submit that the instant claims are in condition for allowance and respectfully request the Examiner to find them allowable.

Respectfully submitted,

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Date: February 22, 2001

[1] 37 CFR 1.601 Scope of rules, definitions
(n) Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".